



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,397	04/20/2000	Richard R. Reisman	2222.4310009	4230

26111 7590 09/08/2008
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

NGUYEN, TANH Q

ART UNIT	PAPER NUMBER
----------	--------------

2182

MAIL DATE	DELIVERY MODE
-----------	---------------

09/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/553,397	Applicant(s) REISMAN, RICHARD R.	
	Examiner TANH Q. NGUYEN	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26, 28-35, 37 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26, 28-35, 37 and 39-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 10, 2008 has been entered.

Information Disclosure Statement

2. Applicant submits that there is nothing in the rules and in the MPEP that mentions anything about admitting an actual date of publication where the document submitted contains a publication date. Applicant further indicates that in making the submission, applicant acknowledges that several documents are dated, and that applicant cannot guarantee that the documents were in fact made publicly available as of their stated publication dates. Since the dates may be incorrect, and since the examiner does not have any means for readily determining whether the dates are correct, the examiner considers all the dates to be incorrect. In conformance with the rules, the examiner cannot acknowledge documents with incorrect information (note that Form 1449 has a provision for crossing out documents that are not in conformance and not considered at the bottom of the form; documents with incorrect information are considered not in conformance and are not to be acknowledged by the examiner).

Art Unit: 2182

Furthermore, determining whether the dates on the documents are correct would **substantially increase the burden of examination.**

Applicant also indicates that the examiner is free to use the publication dates as effective dates, but reserves the right to challenge any stated publication date should it become necessary or desirable to do so. In so doing, applicant essentially provides the examiner with a mountain of references without pointing out which of the references have correct dates, and **substantially increase the burden of examination - if and when references with incorrect dates from the IDS are used.**

The examiner suggests that applicant submits a new IDS listing only references with correct dates for consideration. Note that the IDS filed August 9, 2007 has already been processed and mailed to applicant. A new IDS is required if applicant still wishes to have the references with correct dates considered. Applicant can indicate that the references listed were previously provided when submitting the new IDS.

3. Applicant points out certain references that were submitted prior to the submission of the IDS of August 9, 2007. Applicant needs to submit a new IDS without those references because the IDS of August 9, 2007 has already been processed and mailed to applicant.

4. Applicant indicates that the documents submitted in the IDS of August 9, 2007 were presented in an abundance of caution in connection with two litigations and applicant's related applications, that the documents were not reviewed in detail in connection with the herein claimed invention, and that applicant is not aware that any of

Art Unit: 2182

the documents are more material to the claims of the current application than the references already considered by the examiner.

It is not clear to the examiner what applicant meant by - applicant being not aware that any of the documents are more material to the claims of the current application than the references already considered by the examiner. It appears that applicant intends for the documents to be not material to the claims of the current application. Accordingly, unless applicant specifically indicates the documents that are material to the claims of the current application in the new IDS - by pointing out the relevancy of the documents that are material to the claims of the current application, the examiner will consider that none of the documents in the new IDS are material to the claims of the current application, that the documents are presented in an abundance of caution, and that the documents are material only to the two litigations and only material to the applications involved in the two litigations.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20-21, 25, 32 are rejected under 35 U.S.C. 112, first paragraph, as failing

Art Unit: 2182

to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

“selecting the one of the plurality of independently operated data sources from a **listing of each of the plurality of independently operated data sources**” - as recited in claims 20-21, 32;

“wherein the method is performed a plurality of consecutive times, wherein **during each time** the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed” - as recited in claim 25; and

Applicant is required to either remove the new matter, or specifically point out in the disclosure the support for the above limitations - in the reply to this Office Action.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16-26, 28-35, 37, 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US 4,706,121) in view of Joseph et al. (US 5,819,034).

Art Unit: 2182

10. As per claim 16, Young teaches a method for operating a user station [Abstract], comprising:

receiving at the user station a schedule in a containing information product (CIP) [user receiving a schedule in a TV guide - Abstract, line 4; col. 1, line 51; col. 7, line 8];

receiving a broadcast data stream [135, FIG. 2] containing at least one desired data object (Abstract, lines 5-15);

monitoring the broadcast data stream for the at least one desired data object based on the schedule in the CIP [Abstract, lines 10-15]; and

capturing and storing the at least one desired data object from the received broadcast data stream based on information in the CIP, including the schedule in the CIP [schedule information from FM receiver - Abstract, line 4; Abstract, lines 15-17].

Young does not specifically teach capturing and storing the at least one desired data object in the broadcast data stream based on an object identifier contained in the broadcast data stream, the at least one desired data object being identified by the object identifier contained in the broadcast data stream.

Joseph teaches an object identifier contained in a broadcast data stream to allow for identification of the data in the broadcast data stream in order to multiplex several independent data streams in a single data stream [col. 4, lines 33-39], and capturing and storing at least one desired data object identified in the broadcast data stream based the object identifier contained in the multiplexed broadcast data stream [col. 4, line 66-col. 5, line 9].

It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 2182

invention was made to use an object identifier contained in a broadcast data stream to allow for identification of the data in the broadcast data stream, as is suggested by Joseph, in order to allow for multiplexing of several independent data streams in a single data stream - hence allowing for capturing and storing at least one desired data object identified in the multiplexed broadcast data stream based the object identifier contained in the broadcast data stream.

Young teaches a user receiving schedule information regarding TV programs and using the schedule information to capture and store the desired TV programs from the broadcast data stream [Abstract]. Since there is no reason for a user to capture and store TV programs that have been previously received and stored at the user station, the user would ignore such TV programs, and capture only new TV programs using the schedule information. For example, if the schedule information shows program A being broadcasted according to the schedule information, the user would capture and store program A according to the schedule information - only if program A has not been previously received and stored. Young therefore suggests comparing the at least one desired data object to a data object previously received and stored at the user station; determining whether the at least one desired data object contains newer data than the previously stored data object; and if so, then capturing and storing the at least one desired data object from the received broadcast data stream, and if not, then ignoring the desired data object.

11. As per claims 17-19, Young teaches recording the selected program on a VCR (Abstract, lines 15-17), hence the at least one desired data object being stored in

Art Unit: 2182

temporary storage at the user station (video tape for storing the selected program); the selected program being recorded on a VCR (Abstract, lines 15-17), hence fetching the at least one desired data objects from the temporary storage when the videotape is played back on the VCR; a TV receiver [126, FIG. 3] at the user station, the TV receiver being capable of receiving the selected program from the VCR and displaying the selected program on the TV monitor, hence preparing the fetched at least one desired data object for use at the user station.

Joseph teaches the at least one desired data object being stored in temporary storage at the user station, fetching the at least one desired data object from the temporary storage, preparing the fetched at least one desired data object for use at the user station [col. 5, lines 5-9].

12. As per claims 20-22, Young teaches selecting a data source from a listing of a plurality of independently operated data sources (HBO, ESPN...) for supplying the selected program (col. 4, lines 14-24; col. 10, line 11-col. 12, line 42), hence the at least one desired data object being supplied by one of a plurality of independently operated data sources and selecting the one of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources; an application programming interface [220, FIG. 5; 116, 118, FIG. 3] providing inputs to a CPU [110, FIG. 3] for supplying user selection (col. 7, lines 51-54; col. 9, line 46-col. 10, line 10), hence an application programming interface enabling a software application to select the one of the plurality of independently operated data sources; the broadcast data stream being broadcasted by a data source from a plurality of independently

Art Unit: 2182

operated data sources including HBO, ESPN... (col. 4, lines 14-24) to the subscribers of such data sources, hence the data stream being multicast.

Joseph further teaches the at least one desired data object being received from (or supplied by) one of a plurality of independently operated data sources [channel sources 108, 108A - FIG. 2; col. 9, lines 43-51] and selecting the one of the plurality of independently operated data sources from the plurality of independently operated data sources [col. 12, line 66-col. 13, line 2; col. 4, lines 54-56], and an application programming interface enabling a software application to select the one of the plurality of independently operated data sources [col. 12, lines 56-65]. Joseph does not specifically teach selecting one of the plurality of independently operated data sources from a listing of the plurality of independently operated data sources. Since it was known at the time the invention was made to list a plurality of independently operated data sources to make it easier for a user to select an independently operated data source, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do so, in order to facilitate the selection by the user.

Joseph does not teach the broadcast data stream being broadcast by Internet multicasting. Since applicant discloses the broadcast information distribution system being an alternative to modem-based wireline or wireless calling to a server; and on the Internet, such broadcasting to a selected group of recipients is called multicasting (page 38, lines 22-27), the use of a broadcast information distribution system or Internet multicasting is not significant, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Internet multicasting in order to

Art Unit: 2182

practice the Joseph's invention in an Internet environment.

It was known in the art at the time the invention was made for information from the Internet being multicast to subscribers via a router/distributor in order to constantly receive the information without incurring telephone connection costs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such teachings into Joseph, in order to avoid incurring telephone connection costs.

13. As per claims 23-24, Young teaches tuning the user station to receive the broadcast data stream (col. 4, lines 48-52; Abstract, lines 10-17); the broadcast data stream being broadcasted by a data source from a plurality of independently operated data sources including HBO, ESPN... (col. 4, lines 14-24) to the subscribers of such data sources, hence the at least one desired data object comprising data to which a user at the user station is entitled.

Joseph teaches tuning the user station to receive the broadcast data stream [col. 4, lines 54-56]; the at least one desired data object comprising data to which a user at the user station is entitled [entitlement with a cable system [col. 2, line 26; col. 7, line 9].

14. As per claim 25, Young teaches the claimed invention except for the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have been previously been captured and stored during a prior time the method is performed. In essence, Young's VCR does not allow for receiving, capturing and recording additional desired data objects while enabling the user to play back desired data objects that have

Art Unit: 2182

been previously been captured and stored. Young, however, teaches recording of selected programs with a recording device that is other than a VCR (col. 3, lines 53-56). It was known in the art at the time the invention was made for a recording device that allows for additional desired data objects to be received, captured and stored while enabling the user to play back desired data objects that have been previously been captured and stored. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such recording device into Young's method since Young teaches the use of a recording device that is other than a VCR and since the incorporation of such device would allow Young's method to be performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have been previously been captured and stored during a prior time the method is performed. The combination would, likewise, allow the user station to enable the user to access the captured and stored desired data objects while the user station receives, captures and stores additional desired data objects.

Joseph teaches the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed [col. 5, lines 32-44].

15. As per claim 26, Young teaches the user at the user station selecting the at least one desired data object to be captured and stored (col. 7, lines 51-54); Joseph teaches a user at the user station selecting the at least one desired data object to be captured

Art Unit: 2182

and stored [col. 12, lines 56-65].

16. As per claims 28-35, 37, the claims generally correspond to claims 16-20, 22-24, 25-26 and are rejected on the same bases.

17. As per claims 39-42, Young/Joseph teaches capturing and storing the desired data object according to the schedule (see rejection of claim 16 above) and the method being performed a plurality of times (see rejection of claim 25 above), hence repeating the capturing and storing according to the schedule; an updated version of the desired data object [update of programs in Young; col. 7, lines 25-28 of Joseph]; and optionally purging prior versions of the desired data object by a user [col. 13, lines 37-42].

18. As per claims 43-44, Joseph teaches a method for operating a user station [20, FIG. 1], comprising:

receiving information to cause the user station to watch for at least one desired data object in a broadcast data stream [col. 12, lines 56-65], the broadcast data stream including the at least one desired data object and the at least one desired data object being identified in the broadcast data stream by an object identifier (packet identification information) contained in the broadcast data stream [col. 4, lines 33-39];

receiving the broadcast data stream [via high speed data link 30, FIG. 1], and capturing and storing the at least one desired data object from the received broadcast data stream based on said information, the at least one desired data object's object identifier contained in the broadcast data stream [col. 4, line 66-col. 5, line 9].

Joseph further teaches repeating the capturing and storing (see rejection of claim 25 above), an updated version of the desired object (see rejection of claim 40 above),

Art Unit: 2182

and optionally purging prior versions of the desired data object by a user (see rejection of claims 41-42 above).

Joseph also teaches the method including broadcasting a home shopping show [col. 8, lines 22-25]. Since it was known in the art at the time the invention was made for a home shopping show to be scheduled as shown on a TV Guide, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a TV Guide to determine when the home shopping show is on to shop, hence capturing and storing the desired data object in accordance with the schedule of the home shopping show.

Furthermore, since it was known in the art at the time the invention was made to use a revised TV Guide to determine when a show is on, hence fetching a revised schedule to determine when the home shopping show is on in order to shop in accordance with the revised schedule for the home shopping show. Note further that it was known to fetch a TV guide from a broadcast data stream.

19. As per claims 45-46, the claims generally correspond to claims 39-40 and are rejected on the same bases.

20. As per claims 47-48, see the rejections of claims 41, 42 above.

21. As per claims 49-50, the claims generally correspond to claims 43-44 and are rejected on the same bases.

Response to Arguments

22. Applicant's arguments filed July 10, 2008 with respect to the 112 rejections have

Art Unit: 2182

been fully considered but they are not persuasive or moot in view of the amendments.

A. Applicant argues that page 8, lines 9-14; page 65, lines 19-25; page 66, line 15-page 67, line 3; and page 72, lines 7-14 of the specification provide support for “selecting the one of the plurality of independently operated data sources from a **listing of each of the plurality of independently operated data sources**”

“wherein the method is performed a plurality of consecutive times, wherein **during each time** the method is performed, a user at the user station can access desired data objects that have previously been captured and stored during a prior time the method is performed”

The argument is not persuasive because it is not clear to the examiner how the cited sections support the above limitations. Applicant needs to specifically show to the examiner how the cited sections read on the claims.

At best, page 66, line 15-page 67, line 3 of the specification discloses browsing a realtor's listings with an offline browser and updating the realtor's listings via the Internet or the telephone network. There is nothing else to support the limitations above. Note that the realtor's listings are operated by the realtor and there is nothing in the disclosure that suggests the realtor's listings being independently operated.

At best, page 72, lines 7-14 discloses the offline browser automatically accessing the most up-to-date version of any particular content element. It does not appear that the cited section supports the limitations above.

B. Applicant argues that applicant does not understand how the antecedent basis for the "logic for capturing and storing" in claims 47-48 is insufficient because

Art Unit: 2182

claims 47-48 depend on claim 28, which clearly recites "logic for capturing and storing the at least one desired data object from the received broadcast data stream...". The argument is not persuasive because claims 47-48 previously depend on claim 44.

The argument is now moot in view of applicant's amendment to make claims 47-48 depend on claim 28, instead of being dependent on claim 44.

23. Applicant's arguments with respect to the pending claims on art rejections have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANH Q. NGUYEN whose telephone number is (571)272-4154. The examiner can normally be reached on M-F (9:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TARIQ HAFIZ can be reached on (571)272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 2182

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TANH Q. NGUYEN/
Primary Examiner, Art Unit 2182

TQN: September 3, 2008